

Elimination of the Listing of Prior Art Documents on Reexamination Certificates

Currently, the United States Patent and Trademark Office (Office) includes on each reexamination certificate a list of all prior art documents cited by patent owner and third parties that were considered by the Office and all prior art documents cited by the Office in the reexamination proceeding. In order to expedite issuance of reexamination certificates, the Office is eliminating printing of the listing of prior art documents on reexamination certificates.

The Office's Public Patent Application Information Retrieval (PAIR) system provides electronic listings of the prior art documents considered and cited by the Office in each reexamination proceeding. Therefore, printing such information on reexamination certificates is no longer necessary. The reexamination certificate will now include a notice thereon stating that the list of cited prior art documents will be available via PAIR by reexamination control number. Members of the public can access Public PAIR to conveniently obtain the list of prior art documents cited by inputting the reexamination control number and viewing each list of cited prior art documents.

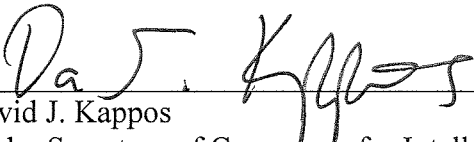
Furthermore, the Manual of Patent Examining Procedure (MPEP) currently indicates, at sections 2290 and 2690, that the reexamination certificate will include: "[t]he prior art documents cited at INID code [56] will be only those which are part of the reexamination file and cited on forms PTO-1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) (and the documents have not been crossed out because they were not considered) and PTO-892." Since the listing of prior art documents will be eliminated from the reexamination certificate, the MPEP, in chapters 2200 and 2600, will be updated to reflect this new practice.

On June 18, 2011, a new Display References tab became available in Public PAIR where, under the heading "Reference Forms," all prior art listings (PTO-892, PTO-1449, IDS) in the file are available. These listings can now be easily viewed and downloaded from this new tab. Note: These same forms and documents are still available on the Image File Wrapper tab.

Any inquiry regarding this notice may be directed to Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, by telephone at (571) 272-7755 or (571) 272-7701, or by electronic mail at PatentPractice@uspto.gov.

Date:

9/9/11


David J. Kappos

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office